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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,022	12/15/2000	Lisa Marie Thomasco	00159PHRM284	9402
34135	7590	06/18/2004	EXAMINER	
COZEN O ' CONNOR, P.C. 1900 MARKET STREET PHILADELPHIA, PA 19103-3508			BERNHARDT, EMILY B	
			ART UNIT	PAPER NUMBER
			1624	
DATE MAILED: 06/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/738,022

### Applicant(s)

THOMASCO ET AL.

### Examiner

Emily Bernhardt

### Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/13/03 & 5/27/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/21/01 &amp; 7/26/02</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

Applicants' election of group I subject matter in the response filed 11/3/03 with traverse is acknowledged but not persuasive. While the assay testing is directed to the underlying activity relied on as an antimicrobial for instant compounds, the nonelected use is distinct from said use since pharmaceutical use would be directed to treating mammalian hosts while assay testing would be directed to a variety of targets, none which are particularly recited in the assay claims. Additionally, such probes would involve complexation with the biological target as described in the specification on p.7 and thus do not correspond in scope to the products being claimed, namely just the probes. Additionally, differing 112 issues of patentability would arise based on the nature of the assay which is incompletely defined by the current claims. Also, copending, commonly assigned 10/020306 appears to overlap with nonelected use.

Thus the restriction is believed proper and is therefore made FINAL.

The abstract of the disclosure is objected to because there is no structural makeup depicted for instant elected invention. Correction is required. See MPEP § 608.01(b).

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. "Comprising" appearing in main claim 1 is open-ended and thus implies more than what is positively recited. "Having" is suggested.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the preparation of non-radiolabelled compounds as well as tritium,  $^{35}\text{S}$  and  $^{125}\text{I}$ , does not reasonably provide enablement for **all remaining isotopic forms** which specification entails on p.9. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. There are no starting material sources or reaction schemes enabling the preparation of other isotopic forms such as O, N or C that can be present in rings and in chains within the instant formula.

A search in the pertinent art area yielded nothing teaching or suggesting applicants' compounds prior to applicants' filing date.

Claims <sup>3</sup>~~2~~-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

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If attempts to reach the examiner by phone are unsuccessful, the supervisor for AU 1624, Dr. Mukund Shah, can be reached at (571)272-0674.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

*E Bernhardt*

**EMILY BERNHARDT**

**PRIMARY EXAMINER**

**Group 1600**